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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Beauty FX, Inc.

Serial No. 76/238,909

Marc J. Gross of Greenbaum, Rowe, Smith, Raven LLP for
Beauty FX, Inc.

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(Mary I. Sparrow, Managing Attorney).

Before Seeherman, Bucher and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 12, 2001, Beauty FX, Inc. (applicant)
applied, under the intent to use provision of the Trademark
Act, to register on the Principal Register the mark COLOR
FX (in typed form) for goods ultimately identified as
"cosmetics, specifically, nail polish, nail care
preparations, eyeshadow, lip color, namely lip gloss and
lipstick, facial makeup, fragrances, namely perfumes and

colognes, mascara, and non-medicated skin-care preparations" in International Class 3.¹

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of the registration of the mark COLOR EFFECTS (in typed form) for "temporary hair color" in International Class 3.²

The examining attorney argues that the marks are similar because "(1) they share the word 'COLOR,' (2) they are both typed marks, and (3) they are phonetically equivalent." Brief at 4. Responding to applicant's criticism that the examining attorney only considered the phonetic equivalence in determining the similarity of the marks, the examining attorney stated "that this factor was the only significant factor to consider because other factors had no basis for argument." Id. As evidence of the phonetic equivalence, the examining attorney relies on an acronym dictionary and printouts from the U.S. Patent and Trademark Office search system that list "FX" as a pseudo mark for "effects." Regarding the goods, the examining attorney submitted several printouts that show

¹ Serial No. 76/238,909. The application contains a disclaimer of the word COLOR.

² Registration No. 2,232,963 issued March 16, 1999. The registration contains a disclaimer of the word COLOR.

that the same entity has registered cosmetics and hair care products under a common mark.

Applicant submits that the applicant's and registrant's marks have "completely different commercial impressions" (Brief at 6) and that FX can have many meanings. Applicant maintains that the "lack of a single common letter between the second word of COLOR FX and the second word of the Registered Mark is critical in distinguishing the commercial impression." Reply Br. at 4. In addition, applicant argues that while the goods of the parties may be described by the term "cosmetics," "they are cosmetics of different composition, used for different purposes in different channels." Brief at 9-10.

After the examining attorney made the refusal final, this appeal followed.

We reverse.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the

cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first issue we address in this case is the similarity or dissimilarity of the marks. "When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared." Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ 1471, 1473 (Fed. Cir. 1992). The crucial issue in this case is whether the similarity of the marks in sound alone is sufficient to support a holding that there is a likelihood of confusion. We view the examining attorney's statement that the similarity as to sound "was the only significant factor to consider because other factors had no basis for argument" (Brief at 4) as a concession that the marks are different as to appearance and meaning. We would certainly agree that, except for the apparently generic term "color," the marks have significant differences in appearance. Regarding the meanings of the marks, there are also differences. While the entry from the Acronym Finder lists one of the definitions of FX as "effects," it qualifies the meaning with the parenthetical "(special/sound)." To the extent that potential customers

would understand FX to mean "effects (special/sound)," it would have a movie special effects meaning. There is no evidence that registrant's mark would suggest any movie special effects connotation.³ The acronym finder also indicates that FX may be perceived as an acronym for several other words or as an abbreviation for other terms as well as simply the letters "F" and "X."

This brings us to a consideration of the similarity of the sound of the marks. We agree that the terms "FX" and "effects" are phonetically similar to the extent that when the letters F and X are pronounced, they would sound somewhat similar to the word "effects." However, the letters are not necessary phonetic equivalents. In the word "effects," the accent is on the second syllable; while, when the letters FX are pronounced, the letter "F" is given equal emphasis with the letter "X." Compare Traq, Inc. v. Trak, Inc., 212 USPQ 846, 850 (TTAB 1981) ("We conclude that the marks [TRAK and TRAQ] are phonetically indistinguishable. In this regard, we take judicial notice of the fact that the letter 'q' in the English language is always pronounced 'k'"); In re Total Quality Group Inc., 51

³ We also note that other definitions of FX such as "fix" may also come to mind when others see the term FX associated with "color" and used on cosmetics.

USPQ2d 1474, 1476 (TTAB 1999) ("Applicant's mark STRATEGYN and registrant's mark STRATEGEN are phonetic equivalents and differ by only one letter").

When marks are only similar in sound, we proceed a little more cautiously before determining that there is a likelihood of confusion. See e.g. Standard Brands Inc. v. Eastern Shore Canning Co., 172 F.2d 144, 80 USPQ 318, 321 (4th Cir. 1949), cert. denied, 337 U.S. 925 (1949) (V-8 and VA not confusingly similar, "the phonetic similarity of the two marks cannot prevail, even if it is supposed ... that the defendant's goods are asked for as VA rather than as Virginia tomato juice or lima beans"); Crown Radio Corp. v. Soundscriber Corp., 506 F.2d 1392, 184 USPQ 221, 222 (CCPA 1974) ("As we stated in General Electric Company Limited v. Jenaer Glaswerk Shott & Gen, 52 CCPA 954, 341 F.2d 152, 144 USPQ 427 (1965), confusing similarity cannot be predicated on auditory response alone and one must consider the impression on the mind where stimuli of the auditory nerve are registered").

In the present case, while FX can be pronounced similarly to the word "effects," it is not phonetically identical. The simple fact that the letters may be

pronounced similarly is a slender reed on which to base a likelihood of confusion determination.⁴

Inasmuch as there are admitted dissimilarities in appearance and meaning between the marks and the phonetic similarity is not unequivocal, we find that, when the marks are considered in their entirety, their differences outweigh their similarities.

Next, we compare the goods of applicant and the registrant. Here again, there are differences. Registrant's goods are limited to temporary hair color. Applicant's goods are nail polish, nail care preparations, eyeshadow, lip gloss, lipstick, facial makeup, perfume, cologne, mascara, and non-medicated skin-care preparations.⁵ The examining attorney has submitted seven use-based registrations to establish a relationship between applicant's and registrant's goods. Six of the

⁴ The examining attorney's only other "evidence" on this point consists of printouts from the Office's electronic database showing that in the database's pseudo mark field the Office has treated the letters "FX" as a pseudo mark for "effects." We have not considered this evidence. Because there is no procedure for applicants or third parties to challenge how the Office determines whether terms are "pseudo marks," the manner the Office enters a mark into its electronic search system is for the convenience of the Office. It cannot enhance or decrease the likelihood of confusion. Accord 15 U.S.C. § 1112 ("The Director may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant's or registrant's rights").

⁵ Applicant deleted any goods directed to hair care.

registrations concern hair care products such as shampoo that are not the same as registrant's hair coloring products. There is one registration for highlighter (Registration No. 2,561,598), which can be a type of hair color product. However, we do not think this single registration is sufficient in the context of these particular goods to show that temporary hair color and the cosmetics identified in the application are the type of goods that may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993). We do not question that there is some relationship between applicant's and registrant's goods. However, we note that these goods are not identical and that the differences between the products are not inconsequential.

When we consider that the marks are different in appearance and meaning and the phonetic similarity is not identical, we find that the commercial impressions of the marks are different. When these marks are then used on different goods that are in the general field of health and beauty products, we hold that there is no likelihood of confusion.

Decision: The refusal to register is reversed.